

**Amendment and Response**

Serial No.: 10/718,359

Confirmation No.: 3660

Filed: November 20, 2003

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**For: NaCT AS A TARGET FOR LIFESPAN EXPANSION AND WEIGHT REDUCTION**

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**Remarks**

The Office Action mailed August 7, 2008, has been received and reviewed. Claims 12, 13, 20, 21, 50, 78, 79, 82, and 83 having been amended, claims 1-11, 14-19, 22-26, 29-49, 51-56, 58-75, 80, and 81 having been canceled, without prejudice, and claims 84-136 having been added, the pending claims are claims 12, 13, 20, 21, 27, 28, 50, 57, 76-79, and 82-136. Claims 57, 76, and 77 being withdrawn from examination as drawn to non-elected inventions, the claims currently under examination are 12, 13, 20, 21, 27, 28, 50, 78, 79, and 82-136. Reconsideration and withdrawal of the rejections are respectfully requested.

Support for amended claims 12, 13, 20, 50, 78, 79, 82, and 83, and new claims 96 and 97 (drawn to polypeptides wherein the polypeptides comprise amino acids 500 to 520 of the rat NaCT transporter polypeptide (SEQ ID NO:4)) and new claims 84-95, 98, and 99 (drawn to polypeptides wherein the polypeptides comprise a leucine at position 500) is found in Example 7, pages 119-129 of the specification. For example, the Examiner is directed to page 121, lines 4-8 and page 126, line 20 to page 127, line 1 of the specification. Support for the recitation "wherein the stoichiometry of transport coupling is 4:1" in new claims 114, 116, 118, 120, 122, 124, 126, and 128 is found, for example, on page 21, lines 16-19 of the specification. Support for the recitation "wherein the polypeptide transports the tricarboxylate citrate with a higher affinity than a dicarboxylate" in new claims 129-136 is found, for example, on page 3, line 16-17 of the specification.

**Examiner Interview**

Telephonic communications were held between Primary Patent Examiner Michael Pak and Applicants' Representative, Nancy Johnson, on August 14, 2008, and August 21, 2008. Applicants' Representative requested clarification of the status of the claim rejections under 35 U.S.C. 112, first and second paragraphs, of record in the previous Office Action mailed October 18, 2007. Examiner Pak clarified that the claim rejections under 35 U.S.C. 112, first and second

paragraphs, of record in the Office Action mailed October 18, 2007, are withdrawn in the Office Action mailed August 7, 2008.

**The 35 U.S.C. §102 Rejection**

The Examiner has made several rejections under 35 U.S.C. 102(e). Claims 12, 13, 20, 21, 27, 28, 50, 78, 79, 82 and 83 were rejected as being anticipated by SEQ ID NO:2 of Curtis et al. (US 2002/0193582). Claims 12, 13, 20, 21, 27, 28, 50, 78, 79, 82 and 83 were rejected as being anticipated by SEQ ID NO: 1 of Nakanishi et al. (US 2004/0253597). Claims 12, 13, 20, 21, 27, 28, 50, 78, 79, 82 and 83 were rejected as being anticipated by SEQ ID NO:994 of Alsobrook et al. (US 2006/0084054). And, claims 12, 13, 20, 21, 27, 28, 50, 78, 79, 82 and 83 were rejected as being anticipated by SEQ ID NO:72 of Anderson et al. (US 2004/0043930). These rejections are respectfully traversed.

According to MPEP § 2131 a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

As amended, claims 12, 20, 50, 78, 82, and their dependencies are drawn to polypeptides wherein the polypeptides include amino acids 500 to 520 of the rat NaCT transporter polypeptide (SEQ ID NO:4). Applicants respectfully submit that none of Curtis et al., Nakanishi et al., Alsobrook et al., or Anderson et al. teach the claimed polypeptides.

Thus, the disclosures of Curtis et al., Nakanishi et al., Alsobrook et al., and Anderson et al. do not set forth each and every element of claims 12, 13, 20, 21, 27, 28, 50, 78, 79, 82 and 83. The reconsideration and withdrawal of these rejections under 35 U.S.C. §102(e) is respectfully requested.

Further, Applicants submit that Nakanishi et al. (US 2004/0253597) does not qualify as reference under 35 U.S.C. 102(e). Nakanishi et al. is the US national stage application under 35 U.S.C. 371 of PCT/JP02/09444. PCT/JP02/09444 was filed September 13, 2002, and published as WO/2003/025168 on March 27, 2003. PCT/JP02/09444 was filed and published in the

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Japanese language only. As set forth in MPEP 706(f)(1), "where the earlier application is an international application, the earlier international application must satisfy the same three conditions (i.e., filed on or after November 29, 2000, designated the U.S., and had been published in English under PCT Article 21(2)) for the earlier international filing date to be a U.S. filing date for prior art purposes under 35 U.S.C. 102(e)." And, "[i]f the international application was filed on or after November 29, 2000, but . . . was not published in English under PCT Article 21(2), do not treat the international filing date as a U.S. filing date for prior art purposes. In this situation, do not apply the reference as of its international filing date, its date of completion of the 35 U.S.C. 371(c)(1), (2) and (4) requirements, or any earlier filing date to which such an international application claims benefit or priority." Applicants submit that Nakanishi et al. does not qualify as reference under 35 U.S.C. 102(e).

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**Summary**

It is respectfully submitted that the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives at the telephone number listed below if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted

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**CERTIFICATE UNDER 37 CFR §1.8:**

The undersigned hereby certifies that this paper is being transmitted via the U.S. Patent and Trademark Office electronic filing system in accordance with 37 CFR §1.6(a)(4) to the Patent and Trademark Office addressed to the Commissioner for Patents, Mail Stop Amendment, P.O. Box 1450, Alexandria, VA 22313-1450, on this 7 day of November, 2008.

By: Sandy Truchart

Name: Sandy Truchart